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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------------|------------------|
| 09/499,069 | 02/04/2000 | Ted Eugene Wright | 77017.002 | 9708 |
| 34395 | 7590 | 03/18/2005 | | |
| OLYMPIC PATENT WORKS PLLC P.O. BOX 4277 SEATTLE, WA 98104 | | | | |
| | | | EXAMINER CARTER, MONICA SMITH | |
| | | | ART UNIT 3722 | PAPER NUMBER |

DATE MAILED: 03/18/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/499,069
Filing Date: February 04, 2000
Appellant(s): WRIGHT, TED EUGENE

Robert W. Bergstrom
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 7, 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1-7 and 11-21 are pending in the Current Application. Claims 1-5, 7 and 11-21 were rejected in the Office Action dated June 4, 2004.

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (as seen in the previous Office action mailed October 6, 2003).

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-5, 7 and 11-21 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|-----------|----------|--------|
| 3,655,119 | THOMPSON | 4-1972 |
| 4,592,573 | CROWELL | 6-1986 |
| 4,850,611 | SKELTON | 7-1989 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson ('119) in view of Skelton ('611).

Thompson discloses a ticket envelope (10) comprising a registration form (26); an unfolded packet (combination of 22 and 24) separated from the registration form by a score line (40), the unfolded packet including at most two score lines (30 and 36) that allow the unfolded packet to be quickly and accurately folded into a complete packet in two or fewer steps (wherein the first step would be along score 30 and the second step would be along score 36); and a die-cut slot (42) in the unfolded packet which serve as a slot to hold a number of items (i.e., travel tickets, receipt stubs, coupons and the like – see col. 3, lines 2-8; inherently, this would include keys).

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Regarding the packet being a “key” packet, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the packet of Thompson is capable of performing the intended use of being a key packet.

Thompson discloses the claimed invention except for the score lines being lines of perforations.

Skelton discloses a foldable envelope for tickets having a plurality of panels 24, 26, 28, 30, 32, 34, 36, 38, 40) separated from each other along adjoining edges by a perforated, embossed, or scored line “so that the panels might be folded, one over the other, and, for purposes later described, may be severed and separated, one from the other, along the perforated or embossed line” (see col. 2, lines 53-61). Skelton shows that scores and perforations are equivalent structures known in the art. Therefore, because these two creasing methods were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute lines of perforations for the score lines in Thompson.

Regarding claims 2-4, Thompson, as modified by Skelton, discloses the panels being pre-printed with textual and graphical information (as seen in col. 4, lines 53-56 of Skelton – “may be printed with advertisement materials....printed display symbols and

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the like"). Note, it is inherently known that the printing would be generated by a conventional printing device.

Regarding claim 5, Thompson, as modified by Skelton, discloses the form and packet being rectangular and, when in the fully folded state, has a greater vertical dimension than a horizontal dimension (as seen in figure 1 of Thompson). Thompson, as modified by Skelton, further discloses that the registration form comprises the top portion of the registration form and packet and the registration form is separated from the unfolded packet by a horizontal line of perforations (viewing the envelope in figure 1 at a ninety degree angle would provide the horizontal line of perforations separating the top portion having the form from the bottom portion having the packet).

Regarding claim 7, Thompson, as modified by Skelton, discloses including a number of items in the packet (see col. 3, lines 2-8); this would, inherently, include keys consisting of metal keys and magnetic keys. It is further noted that the keys do not structurally limit the registration form and packet.

2. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Skelton and further in view of Crowell ('573).

Regarding claims 11 and 16, Thompson discloses a ticket envelope (10) comprising a registration form (26); an unfolded packet (combination of 22 and 24) separated from the registration form by a score line (40), the unfolded packet including at most score lines (30 and 36) that allow unfolded packet to be quickly and accurately folded into a complete packet in two or fewer steps (wherein the first step would be

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along score line 30 and the second step would be along score line 36); and a die-cut slot (42) in the unfolded packet which serve as a slot to hold a number of items (i.e., travel tickets, receipt stubs, coupons and the like - see col. 3, lines 2-8; inherently, this would include keys).

Regarding the packet being a "key" packet, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the packet of Thompson is capable of performing the intended use of being a key packet.

Thompson discloses the claimed invention except for the score lines being lines of perforations.

Skelton discloses a foldable envelope for tickets having a plurality of panels 24, 26, 28, 30, 32, 34, 36, 38, 40) separated from each other along adjoining edges by a perforated, embossed, or scored line "so that the panels might be folded, one over the other, and, for purposes later described, may be severed and separated, one from the other, along the perforated or embossed line" (see col. 2, lines 53-61). Skelton shows that scores and perforations are equivalent structures known in the art. Therefore, because these two creasing methods were art-recognized equivalents at the time the

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invention was made, one of ordinary skill in the art would have found it obvious to substitute lines of perforations for the score lines in Thompson.

Thompson, as modified by Skelton, discloses the claimed invention except for explicitly disclosing the registration form and packet being printed on a printing device (commercially available computer laser printer).

Crowell discloses a foldable sheet (30) that can be printed on by a computer printer (to, inherently, include laser printers) (see col. 2, lines 45-51). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Thompson's invention to include pre-printing information on the envelope by way of a computer printer, as taught by Crowell, to provide the envelope with advertising indicia and other related information to convey information to the user of the envelope.

Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the packet of Thompson is capable of performing the intended use of being fed through a commercially available computer printer.

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Regarding claims 12 and 17, Thompson, as modified by Skelton and Crowell, discloses the registration form and packet being made of any suitable paper stock (see col. 1, lines 63-66 of Thompson).

Regarding claims 13-15 and 18-20, Thompson, as modified by Skelton and Crowell, discloses the panels being pre-printed with textual and graphical information (as seen in col. 4, lines 53-56 of Skelton – “may be printed with advertisement materials....printed display symbols and the like”). Note, it is inherently known that the printing would be generated by a conventional printing device.

Regarding claim 21, Thompson, as modified by Skelton and Crowell, discloses the single sheet being rectangular (as seen in figure 1 of Thompson).

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(11) Response to Argument

Whether the Examiner has offered substantial new grounds for rejection in the Office Action of June 4, 2004 that would supplement or eclipse the issues already identified in the Appeal Brief originally filed by Applicants on March 5, 2004.

Appellant stated that the examiner has simply repeated previously offered rejections using previously cited references. The examiner disagrees. The first Office

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action mailed October 11, 2000 included rejections of claims 1-6 under 35 U.S.C. 103 over Cowan ('396) in view of Welt ('485) and claim 7 under 35 U.S.C. 103 over Cowan in view of Welt and further in view of Holcomb et al. ('085). The next Office action mailed April 27, 2001 included rejections of claims 1-6 under 35 U.S.C. 103 over Skelton ('611) in view of Cowan and further in view of Thompson ('119) and claim 7 under 35 U.S.C. 103 over Skelton in view of Cowan and Thompson and further in view of Holcomb et al. The Office action mailed October 09, 2001 included rejections of claims 1-6 under 35 U.S.C. 103 over Skelton in view of Cowan and further in view of Jacobs et al. and claim 7 under 35 U.S.C. 103 over Skelton in view of Cowan and Jacobs et al. and further in view of Zoland ('956). The Office action mailed March 6, 2002 included the same rejections as previously set forth in the Office action mailed October 09, 2001. The Office action mailed August 27, 2002 included the same rejections as previously set forth in the Office action mailed October 09, 2001 and further included rejections of claims 11-15 under 35 U.S.C. 103 over Skelton in view of Cowan and Jacobs et al. and further in view of Pacione ('401). The Office action mailed February 21, 2003 included the same rejections of claims 1-7 and claims 11-15 were rejected under 35 U.S.C. 103 over Skelton in view of Cowan and Jacobs et al. and further in view of Pacione ('978). The Office action mailed October 06, 2003 included rejections of claims 1 and 7 under 35 U.S.C. 102(b) as being anticipated by Thompson, claims 2 and 5 were rejected under 35 U.S.C. 103 over Thompson and claims 3, 4 and 11-21 were rejected under 35 U.S.C. 103 over Thompson in view of Crowell ('573). The final Office action submitted by the examiner included rejections of claims 1-5 and 7

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under 35 U.S.C. 103 over Thompson in view of Skelton and claims 11-15 under 35 U.S.C. 103 over Thompson in view of Skelton and further in view of Crowell.

The examiner, therefore, disagrees with appellant's statement that the current rejections were previously offered.

Appellant argues that the examiner never responded to, nor apparently substantively considered the Declaration provided in the Appeal Brief submitted March 5, 2004. The examiner disagrees. As seen in the Office actions mailed August 27, 2002, February 21, 2003 and October 06, 2003, the Declaration and exhibits submitted August 05, 2002, May 27, 2003 and July 21, 2003 (which was a copy of the same exhibits previously submitted) were considered and a response was submitted. The examiner stated that the declaration was insufficient to overcome the rejections since it referred only to the system described in the application and did not address the individual claims.

The examiner continues to maintain that the declaration is insufficient to overcome the currently set forth rejections. Appellant stated that the declaration provided evidence of commercial success. Appellant has failed to successfully establish commercial success since appellant failed to provide cost information associated with appellant's product as compared to the cost of other products provided by their competitors. Appellant has merely established commercial usability not commercial success as asserted by appellant.

Furthermore, appellant's declaration does not address the obviousness rejections as set forth in the Office action. Appellant's declaration addresses the

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commercial success of the product and does not address the patentability of the presently claimed invention. As stated above, appellant has failed to adequately provide evidence of commercial success.


Appellant provides a copy of remarks filed in a previously submitted amendment on pages 6 through 7 of the Brief. Appellant's remarks are moot since they are not directed to the currently set forth rejections of Thompson in view of Skelton and Crowell. The remarks are drawn to rejections previously set forth in earlier Office actions that have not been maintained.

The examiner asserts that the ticket envelope of Thompson, as modified by Skelton and Crowell, discloses the structure of appellant's presently claimed invention as set forth in the above rejections. It is noted that Skelton has been used solely for disclosing that equivalent processes of scoring and perforating substrates and has not been relied upon for disclosing any of the other claimed limitations.

It is further noted that Crowell has been used solely for disclosing that a foldable sheet can be printed on by a computer printer (which would inherently include a laser printer) and has not been relied upon for disclosing any of the other claimed limitations.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Monica S. Carter
Primary Examiner
Art Unit 3722

March 15, 2005

Conferees


Derris Banks
Supervisory Patent Examiner
Art Unit 3722


Greg Vidovich
Supervisory Patent Examiner
Art Unit 3711

ROBERT BERGSTROM
BLACK LOWE & GRAHAM PLLC
816 SECOND AVENUE
SEATTLE, WA 98104